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Paper No. 21
AD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re World of Leather, Inc.

Serial No. 75/549,080

L. Lawton Rogers, III of Rogers & Killeen for World of
Leather, Inc.

Mary R. Henely, Trademark Examining Attorney, Law Office
108 (David Shallant, Managing Attorney).

Before Simms, Walters and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

In this appeal, World of Leather, Inc. (applicant)
seeks to register the mark shown below for services
ultimately identified as "retail store services featuring
leather furniture" in International Class 35:¹

¹ Application Serial No. 75/549,080 was accorded a filing date of July 20, 1999. The application alleges a date of first use of April 1, 1997 and a date of first use in commerce of June 1, 1997. It also contains a disclaimer of the word "leather."



The design element on the left of the drawing consists of a sofa. A clearer copy of the drawing is now in the file.

The Examining Attorney has refused to register applicant's mark because of a prior registration for the mark LEATHER WORLD (in typed form) for services identified as a "retail furniture store featuring leather goods"² under Section 2(d) of the Trademark Act. 15 U.S.C. § 1052(d). The registration disclaims the word "leather."

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs. An oral hearing was not requested. We affirm the Examining Attorney's refusal to register.

The Examining Attorney argues that the marks are a simple transposition of the words "leather" and "world." When the words are transposed as "leather world" and "world of leather," they have the same commercial impression. The Examining Attorney submits that the commercial impression is that of a "large selection of leather furniture."

² Registration No. 2,099,198, issued September 23, 1997.

Examining Attorney's Br., p. 5. The Examining Attorney was not persuaded that the design of a sofa for a retail store featuring leather furniture would be the dominant element such that it would make confusion between the marks unlikely. In addition, the Examining Attorney submits that the services are "virtually identical." Examining Attorney's Br., p. 10.

Applicant, on the other hand, maintains that the services are not identical. It also argues that the design is important since the words "leather" and "world" are weak because they are either descriptive or highly suggestive. Therefore, applicant submits that the marks create different commercial impressions and there is no likelihood of confusion.

Determining whether there is a likelihood of confusion requires consideration of the factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We begin our analysis by considering the similarities and dissimilarities between the marks in the application and registration. Registrant's mark is for words LEATHER WORLD while applicant's mark is for the words WORLD OF LEATHER and the design of a sofa. Both marks contain the words "leather" and "world." Applicant has taken the only two elements of registrant's mark and transposed the words with the word "of" between them. In addition, it has added a border with a design of a sofa. While there are differences, we find that these difference are outweighed by the similarities of the marks. First, the words "leather" and "world," the identical words from registrant's mark, are prominently featured in its mark. They are depicted in much larger type than the only other word applicant adds, the preposition "of." We agree with the Examining Attorney that the words create the same commercial impression, i.e., a large selection of leather furniture.

Applicant does argue that the design element is important here because the words "leather" and "world" are descriptive or highly suggestive. The mere fact that a mark consists of descriptive and highly suggestive terms does not mean that the words would not be the dominant part of the mark. In re National Data Corporation, 753 F.2d

1056, 224 USPQ 749, 752 (Fed. Cir. 1985) ("Assuming CASH MANAGEMENT is generic or at least highly descriptive in both marks, as urged by National, does not, however, lead to a reversal in this case." CASH MANAGEMENT EXCHANGE held confusingly similar to CASH MANAGEMENT ACCOUNT). In the present case, there are even fewer significant differences between the marks.

In addition, the design of a sofa for a store selling furniture is hardly unusual, and it is highly unlikely that the design would dominate the mark in this case. The Federal Circuit held that the addition of the words "The" and "Cafe" and a diamond-shaped design to registrant's DELTA mark still resulted in a likelihood of confusion. In re Dixie Restaurants, 105 F.3d 1405, 1406, 41 USPQ 1531, 1534 (Fed. Cir. 1997) (more weight given to common dominant word DELTA). See also In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988) (BIGG'S and design for grocery and general merchandise store services found likely to be confused with BIGGS and different design for furniture); Giant Foods, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983)(Differences between GIANT HAMBURGERS and design and GIANT and GIANT FOODS and designs not sufficient to overcome the likelihood of confusion); Wella

Corp. v. California Concept Corp., 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design likely to be confused with CONCEPT for hair care products).

We are also not persuaded that the reversing of the order of the words in the marks makes a significant difference.

Further, the reversal in one mark of the essential elements of another mark may serve as a basis for a finding of no likelihood of confusion only if the transposed marks create distinctly different commercial impressions. See: Bank of America National Trust and Savings Assn. v. American National Bank of St. Joseph, 201 USPQ 842 (TTAB 1978), and cases cited therein. Here, where the goods are legally identical, and where both marks, when applied to the goods in question, are likely to be perceived by purchasers as signifying that the product sold thereunder busts through, or breaks up, rust, we agree with the Examining Attorney that the marks create substantially similar commercial impressions, and that there is a likelihood of confusion. Cf. In re Inco, 154 USPQ 629 (TTAB 1967) ["GUARDIAN OF POSTURE" for mattresses versus "POSTURGUARD" for mattresses -- registration refused], and McNamee Coach Corp. v. Kamp-A-While Industries, Inc., 148 USPQ 765 (TTAB 1965) ["KING KAMPER" for camping trailers versus "KAMP KING KOACHES" for campers -- registration refused].

In re Nationwide Industries Inc., 6 USPQ2d 1882, 1884 (TTAB 1988) (RUST BUSTER for rust-penetrating spray lubricants confusingly similar to BUST RUST for penetrating oil).

While applicant disagrees with the Examining Attorney's determination that applicant's and registrant's marks have the same commercial impression, its argument on this point is unpersuasive. "[T]he registrant's mark does

not mean that 'leather or leather products are available in a large selection' but that 'furniture which may or may not be leather is available in large selection.' In contrast, applicant's mark suggests that leather goods, which may or may not be furniture are available in large amounts.'"

Applicant's Reply Br., pp. 3-4 (reference and emphasis omitted). We disagree. LEATHER WORLD for retail furniture store featuring leather goods and WORLD OF LEATHER for retail store services featuring leather furniture would have the same commercial impression. Both would indicate that the stores feature a large selection of leather furniture.

Marks do not have to be identical to be confusingly similar. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1816-17 (Fed. Cir. 1987) (Marks "Commcash" and "Communicash" not identical but strikingly similar). In addition, more or less weight can be given to a particular feature of a mark for rational reasons. National Data, 224 USPQ at 751. While the marks must be considered in their entireties, in this case the marks are similar in sound, appearance, and meaning and, therefore, unless the services of the application and registration are different, confusion will be likely.

Applicant seeks to register its mark for services that it now identifies as "retail store services featuring leather furniture." The services in the cited registration are "retail furniture store featuring leather goods." To determine whether the services are related, we must look to the identification of services in the application and registration. Dixie Restaurants, 41 USPQ2d at 1534; Canadian Imperial Bank, 1 USPQ2d at 1815; Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Here, it is clear that applicant's and registrant's services include the retail sale of leather furniture in addition to other things. At the very least, there is an overlap in the services at this point. We see very little difference between a retail store featuring leather furniture and a retail furniture store featuring leather goods. Both identification of services involve retail stores that feature leather furniture. While other goods could be sold in the stores, there would be an overlap to the extent that the services include the sale of leather furniture. Hyper Shoppes, 6 USPQ2d at 1026 ("Confusion is likely for the "reason that applicant's 'general merchandise store services' would include the sale of furniture ... What else it sells is irrelevant; there is overlap"). Also, because the marks are used, at least in

part, on virtually identical services, there is a greater likelihood that when similar marks are used in this situation, confusion would be likely. Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992) ("When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines").

Applicant also included printouts from a private trademark database, which referred to two registrations for COFFEE WORLD and WORLD OF COFFEE for different goods and services, with its response to the first Office Action. The Examining Attorney objected to this evidence, and we note that these printouts are not from the Office's database. Even if we considered them, they do not change the outcome here. The Examining Attorney has pointed out that the goods and services in the registration to which applicant refers were not virtually identical as they are in this case. Examining Attorney's Appeal Br., p. 9 n.6. Furthermore, we do not have the files of those registrations before us so that it is not clear what lead to the registrations of those marks. Certainly, the registration of two marks for different goods and services hardly justifies the registration of applicant's mark over

the cited registration. In re Hub Distributing, Inc., 218 USPQ 284, 285 (TTAB 1983) ("[E]ven were we to consider the search report credible evidence..., absent evidence of actual use of the marks subject of the third-party registrations, they are entitled to little weight on the question of likelihood of confusion").

Decision: The Examining Attorney's refusal to register applicant's mark on the ground that it is likely to cause confusion with the cited registration under Section 2(d) of the Trademark Act is affirmed.